SUPREME COURT, U. S.

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In The

SUPREME COURT OF THE UNITED STATES

October Term, 1968

No. 1005

EARL E. HOWE,
Petitioner

vs.

GENERAL MOTORS CORPORATION,
Respondent.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Seventh Circuit

REPLY TO RESPONDENT'S BRIEF IN OPPOSITION

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This Reply will take up Respondent's Brief in Opposition page by page, successively, as much as possible, with cross-references to the same subject matter where duplication can be avoided, or the reply made clearer.

POINT I. Page 1,2d par.,2d sent., and p. 3, 2d par. It is sought to prejudice this Court against Howe at the outset, by making

it appear he has been guilty of laches and unclean hands to GM's great damage, and that his claim is stale, '490 having expired in 1957. If ultimately successful, he would be entitled to recover for patent infringement from 1948, his suit having been filed in 1954 (La Buy, J. finding No. 27, Pet.Bk. 18). It is undisputed that Howe notified it, on June 21, 1940, soon after '490 issued (Pet. 9) and kept notifying it periodically in 1941 and 1942 (La Buy, J. finding No. 21, Pet. Bk. 16) that it was infringing '490, and he threatened suit (Pet. 20, par. 2). Intercompany correspondence indicates GM expected, at this time and for some time thereafter, a suit for infringement and misappropriation of confidential information (DA III 1964,1994, La Buy, J. finding No. 33, Pet. Bk. 20). Why did not GM file a declaratory suit? Trial of the laches issue went against it (Brief 3; Pet. 2). This was not the only suit deferred till after War II and the Korean War. Howe's

suit against Atwood, begun March 5, 1941, occupied him fully (See pp. 13-18, 19-21 infra for the strong tie-in with the case at bar). War II, following immediately after, suspended civilian auto production. It was the patriotic duty of all to go all-out in the war effort, as did Howe for the duration. A similar situation arose before Judge Robson in Armstrong v. Motorola, 374 2d 764 (C.A. 7, 1967). Similar situations were cited therein in the 2d, 6th and 8th Circuits.

POINT II. Pages 1, 2, 6, top par., gloss over the twilight areas referred to in Pet. 11-12. They exist in the Seventh, as well as in other Circuits, and in the case at bar. Rule 19(b) relates to important questions in federal law, such as have arisen under the 1952 Patent Act in the case at bar; to a disregard of this Court's decisions, as was true in Disney, 369 F. 2d 230 (C.A. 7, Nov. 9, 1966) (Pet. 11, fn 28;) and in the case at bar; to departures "from the accepted and

usual course of judicial proceedings" when the Circuit Court spelled out in the case at bar some of the first step and all of the third step required under Graham, in determining the issue of unobviousness under Sec. 103, instead of remanding for further investigation and trial, if need be; to a reviewing court's sanctioning "such a departure by a lower court, as to call for an exercise of this court's power of supervision" when, on appeal to it from Judge Robson's judgment, it did not hold the second jury was without jurisdiction ab initio to render a verdict of "Not Guilty", and that Judge Perry's ruling in setting that verdict aside on the ground that it was his legal conclusion the patent was valid and infringed (Pet. 9-10) really constituted a final judgment until reversed (Pet. 14-15).

Appendix C is provided herein should this Court wish to pursue the Rule 19(b) compliance issue. The Petition (11-12) lists ten twilight areas of confusion and contradictions

indicated in the case at bar, in other cases in the Seventh Circuit, and in other Circuits. The case at bar affords opportunities for their much needed resolution. Brief summaries of sample cases only can be made, lest the Memo become a Minibrief. If required, upon grant of certiorari, the full-dress brief can consider the issue more fully. As if to reinforce its point, Respondent states (Brief 2, 1st par.) that the Petition did not state the "Question Presented" with preciseness and clarity. The phrasing of that question is verbatim from the United States' Petition in U.S. v. Adams. Rule 19(b)'s last clause was added to cover the threshhold question, etc. This Court apparently thought that Petition's statement of the question presented, and all questions subsumed under it, adequately precise and clear. The statement (Brief, p. 2, 1st par. line 7) that disclosures in GM's cited prior patents and publications are undisputed is highly presumptuous (Pet. 14,

16, 17, 19, 22, 24, 25-28 disputes this).

POINT III. Page 2, 2d par., is, in some respects, a quibble on form rather than on substance. However proceedings in trial courts may be viewed, such as instructions to the jury, motion for directed verdict, or withdrawal from the jury of a question of law beyond its province, Respondent, throughout the proceedings before Judges La Buy and Perry, recognized that obviousness was a legal conclusion for the trial judge, wherefore motions were made by it repeatedly to withdraw the issue from the jury. When trial of patent infringement suits before a jury was more common, its province was restricted to answering interrogatories in a Special verdict (this Court may wish this opportunity to lay down such guidelines or the kind of questions the jury should answer, to make clear the division of judge and jury functions), the trial judge reserving the determination of invention by either directing the jury to

find it present or absent, or granting a motion N.O.V., or setting aside the jury's verdict. Judge Perry did the latter, and stated as his reasons that (1) the jury was confused (as must have been the predecessor hung jury) by the Respondent's barrage of matter that was either immaterial, such as depositions, or that had been stipulated, for which reason the Court of Appeals modified its decree to cut the cost award in half, and that (2), out of his long experience of having tried over 40 patent infringement suits (Pet. 9, bottom), he had not the slightest doubt '490 was valid and infringed. That his cogent and full opinion, referring to his previously stated findings of evidence and conclusions of law, was given orally does not make it the less formal or less entitled to the weight of judicial pronouncement. Petitioner is at a loss to know why Judge Perry's ruling (Pet. Bk. 22-27) did not constitute an opinion or reasons. That he made

the closing consoling remark to Respondent to let it down easy, does not detract from the force of his statement, repeated in part several times for re-emphasis, as an opinion, without again repeating to counsel the facts and the law, as he had stated he had done. If the second jury usurped jurisdiction in reaching a legal conclusion on obviousness by its verdict of "Not Guilty", why cannot lack of jurisdiction over the subject matter be availed of at any time, even in this Court? POINT IV. Page 3, 1st par., Respondent has failed, at its peril, to object to matters it considered so haughtily as beneath its attention. It dodges reply to a very basic question as to the presumption of '490's validity. On the question of burden of proof on the issue of obviousness, where confidential disclosure had been made to GM (Pet. 8-9, 18-19), the matter is dismissed by denials that the issue of confidential disclosure was ever raised in the pleadings, or was testified to

and contested at the trials, or raised in the Court of Appeals. Judge La Buy's Finding No. 32 (Pet. Bk. 20) indicates GM claimed its 1939 B.O.P. carrying a concealed hinge was the same as Howe's claimed invention, making its employee prior inventor under 102(g). Judge Robson's Decision on the Merits (Pet. Bk. 31, next to last par.) stated that Respondent's Answer "asserted invalidity of the patent on the ground that . . . the alleged invention had been known and reduced to practice by General Motors". (See also La Buy, J. finding 16, Pet. Bk. 15; see also Pet. 24-25) This defense under 102(g) (La Buy, J. finding 16, Pet. Bk. 15; Findings 19-20, Pet. Bk. 16) was hotly contested, General Motors in rebuttal seeking to show that Howe was a mere peddler of an allegedly new product its employee had invented (DA III, 1958, 1964). Yet GM's interdepartmental communication revealed a disposition, after a war of attrition on Howe, to buy him off by compensation which it regarded as

a nuisance fee for the cost of the drawings, models, etc. (DA III 1840-1842; 1854-5; 1966; 1968; 1973)

The Petition for Rehearing to the Court of Appeals (p. 23), requesting it to permit plaintiff to apply to the trial court to amend paragraph 7 of his Complaint (P.A. 29), explained:

> "Since there was no finding as to appellant's common law rights to his secrets disclosed confidentially to the defendant, no issue could be included among the Contested Issues in his appeal to this Court."

Regardless of the above, attention of this Court was drawn to a fact pattern that comes up often enough and in many Circuits, especially the 7th, 2d, 6th and 9th (Pet. Appendix B), as it has in the case at bar, as to which it may use this case to provide guidelines for the Bar and the Courts in the future, on proof am't.

POINT V. Page 3, 3d par., Judge La Buy's denial of Respondent's motion for a directed verdict, at the conclusion of all the evidence,

certainly indicated he did not agree GM's evidence of prior art proved obviousness. A hung jury is ground for no inference it found '490 invalid (GM Brief 9, top), much less the non-sequitur that petitioner failed on the "merits" in both jury trials, since the 12 confused members of those juries may have been of the belief '490 was valid but not infringed. Though Judge La Buy did not rule formally, as by entry of judgment holding '490 valid and infringed, his accord with Judge Picard, as later Judge Perry was in accord with both, is unmistakable in noting that the industry's problem with the tumble in body was more than mere alignment, but that the other problem, or other half of the same problem, was to so align the door that no hinge, or any part of it, would be seen from either outside or from the inside of the car (La Buy, J. findings 18, 19, 20, Pet. Bk. 16).

POINT VI. Page 4, 1st par., Respondent seeks to cast doubt on the soundness of the reviewing

court's denial of its petition for mandamus. That court's opinion (Brief, Appendix) compared the motion for new trial with his opinion to show the proper grant of that motion. Petitioner's errata sheet added a clause on page 15 of the Petition that, in effect, the reviewing court indirectly held with Judge Perry's legal conclusion that '490 was valid and infringed.

POINT VII. Page 4, last line. Rule 23 nowhere requires a petition for certiorari to include a trial court's findings and conclusions of law. Moreover, finality does not attach to them under F.R.C.P. 52(a) where the conclusions of law are based on errors, such as a failure to define accurately the claimed invention in suit, or to follow strictly the Graham procedure under Sec. 103, in the precise order of steps thereunder, or to determine accurately the prior art without which it cannot describe the hypothetically ordinary skilled mechanic in the art, or because they

are conclusory, or because, in weighing the pros and cons, no decision was made on each issue as to which side had the weight of the evidence. All these defects appear in the case at bar.

POINT VIII. Page 5, 2d par. While giving lip service to a licensee's estoppel to deny the validity (Pet. Bk. 8, col. 1, last par. under "Fourth Question"), Judge Picard followed decisional law which has been codified in Sec. 103 and, upon reviewing Howe's invention in'323, he noted no inventive distinguishable feature from the prior art and so held '323 was invalid for non-invention (Pet. Bk. 5, col. 1, last par. under "Third Question"). He followed the same procedure in a consideration of '490 involved in the case at bar (Pet. Bk. 5, col. 1 to p. 8, col.1). Judge Picard defined '490's problems and solutions and the most pertinent prior art so clearly, and then showed the material structural differences between that art and the claimed invention,

producing such different and unexpected results from the prior art, that it is highly persuasive, if not completely dispositive, of the issue of obviousness involved in the case at bar. He concluded (Pet. Bk. 8, col. 1, next to last par. under "Fourth Question"):

> "It is our holding that, where there were hinges with the pintles inclined and aligned on an inclined axis fitted upon a door, or in the depression of the door pillar, to obtain results of the Howe patent made and sold by the defendant, plaintiff may recover."

The industry was plagued with two problems in making the post-De Soto closed, steel car: First, to eliminate "persuasion" to have the door swing substantially horizontal to the ground to enable the door to fit into the opening on the body securely; second, to do so without the use of outside hinge or hinges as support for a concealed hinge.

Judge Picard construed Howe's claims in the light of his drawings. Accordingly, Smith 2,050,469 relied on as the closest to '490, as it was in the case at bar (Note from Pet. Appen-

dix A that Smith recognized the problems in the all steel tumble in auto body and the long-felt needs that still remained unsolved, and had some of the features of '490) because his door could swing substantially horizontal to the ground, was, nevertheless, materially different structurally from '490 and could not solve the problem of doing without exposed support butt hinges in addition to his ball and socket hinge to effect the door's horizontal swing for proper alignment. He claimed that his ball and socket hinge was structurally different from the pintle hinge which he insisted could not be used on the tumble-in body for proper alignment without the use of at least one outside butt hinge for support (Pet. 22; Pet. Book 6).

Atwood, owner of the Smith patent, relied on it as having pioneered the dual inclination axis but Judge Picard explained that '490 was further materially structurally different in that the pintles in '490 were themselves inclined (Pet. Bk. 6, col. 2, last par.):

> "Even in the drawing accompanying the ('490) hinge in which there are two pintles, both the top and bottom pintles are inclined in complete alignment. The claims are all specifically based on an inclined pintle built into the hinge and Claims 3 and 4 are additionally based on a gooseneck hinge member of substantial curvature varying the extent of curvature from top to bottom to compensate for the inclination of the pintle."

Additionally, the hinge members were disposed within the plane of the body wall and door pillar (Pet. 27, top).

Judge Picard's legal conclusion of '490's non-obviousness over the prior art, and especially Smith, was direct and not dictum. He demonstrated there was no identity of structure, mode of operation or results.

POINT IX, page 5, last par., is intended to show non-acceptance of '490 by the industry proved non-invention, and that Judge Robson was, therefore, justified in not considering the secondary indicia of invention, such as the post-De Soto problems, attempts at solution

and their failure by Smith, GM, and others, the replacement by the '490 hinge of the exposed butt hinges, unexpected result, etc., in resolving his doubt on the issue of obviousness. Contrariwise, it was sought to show that it was the GM hinge construction, claimed to have been invented by its employee, which Atwood's auto manufacturer customers were using.

In the period immediately following De Soto, in 1930, standard exposed butt hinges were used to support the heavy doors. Upon its acquisition of Smith, Atwood then made a ball and socket concealed gooseneck construction which embodied Smith's dual inclination axis (this Reply 15). He sold it to Chrysler, which used an exposed butt supporting hinge in addition. It proved unsatisfactory, and was discarded (Pet. Bk. 6, 3d par., last sent.). Upon learning Howe could align the heavy door without "persuasion" and without a hinge that was exposed in any degree, it acquired a

sublicense from Howe's exclusive licensee, Metal Specialty, under a three-party agreement of April 19, 1969. Thereupon, it switched to making Howe's gooseneck pintle type, totally concealed hinge, on which it was obligated to pay royalties. It was sold to Chrysler, De Soto, Dodge and others. They used it on the front door, upper area, of their 1941 model cars, but they had to have an exposed butt hinge, in addition, to support the heavy door. In late 1939-40, GM had the same arrangement on all its models, including the 1939 B.O.P. model, a concealed plus an exposed supporting hinge. This is what is meant in Brief 5, last par., lines 10-14. In 1940, Studebaker used the same arrangement on the Commander, President and Champion models; and so did Nash. In 1939, GM first used the Howe concealed hinge on both the front and rear doors of its Torpedo model. In late 1941, it used the Howe concealed hinge entirely on all models; they had

no exposed hinges.

GM could not thus befuddle Judge La Buy (Findings 18, 19, 20, Pet. Bk. 16), nor Judge Perry before whom testified Beatty (DA 881-82); Hedeen (DA 1519), both GM employees, and Patent Attorney Lutz (DA 1599-1600), that GM's concealed hinge on the 1939 B.O.P. model could not alone support a heavy door and that an exposed hinge was also required.

As indicated in Pet. 2, Atwood repudiated under strange circumstances at the behest of GM, in the light of strong circumstantial evidence. As sublicensee, it assisted in getting the strongest claims possible in the Howe applications (Pet. Bk. 2, 1st par.). Howe had disclosed to GM the contents of his application (which ripened into '490) soon after it was filed on January 9, 1939 (Pet. 8). Atwood began to chisel, refusing to pay royalties on the ground of non-infringement. Dunned constantly, it warned that big automobile companies might challenge Howe's patents (Pet.

Bk. 2, col. 1, last par.). Metal Specialty was obliged, finally, on May 24, 1940 (3 days after '490 issued) to cancel Atwood's sub-license. Atwood had Metal Specialty reconsider, but still refused to pay royalties. Metal Specialty's survival depended on GM which it supplied with sundry metal stampings, such as cowl and ventilator screens. GM threatened, in its usual verbal and subtle manner, to deny it orders unless it ceased its connection with Howe who it had, in the meantime, gulled until he first charged GM with infringement, on June 21, 1940. On September 24, 1940, due to GM pressure, Metal Specialty cancelled its March 16, 1938 agreement and exclusive license with Howe and, on October 1, 1940, so notified GM (DA III 1966) and Atwood whom it also then advised it had assigned to Howe the three-party agreement of April 19, 1939, to which Atwood was a party. On October 3, 1940, Atwood wrote Metal Specialty it would thenceforth deal with Howe. It

refused to pay Howe any royalties. On March 5, 1941, Howe sued Atwood. After being served, on March 21, 1941, Atwood wrote Howe that it no longer recognized the license (Pet. Bk. 2, col. 2, 5th par.).

GM has employed the same oppressive methods by threatening several other of its suppliers, licensees under other Howe patents to Howe's great damage. If the situation were not so pitifully tragic, the statement that he never licensed or himself made the hinge under '490 would be laughable. A comparatively poor man, who could not even afford to pay counsel in the Atwood suit, except on a contingent fee basis, Howe had to settle the judgment in his favor for a pittance because he could not afford the cost of an appeal. Whether he or any other licensee sought to make the hinge and could raise the considerable capital needed, who would buy it? Atwood has been and is still supplying Howe's hinge to the few auto manufacturers. An

oligopoly exists in the auto industry. Since GM's sales account for more than half the cars sold, it belongs and is well nigh a monopsy, the biggest single buyer, to whom thousands of businesses are tributary satellites. Howe had the courage, in due course, with his own meagre funds and borrowed capital, to wage an uneven, gruelling and extremely costly battle against the largest corporation in the United States. At the Atwood trial, its counsel was present throughout and its engineers testified; it did all it could with data, records, prior art, to break '490, short of creating an estoppel. As was said by the 7th Circuit in Devex Corp. v. GM, 321 F.2d 234, 237, col. 2, this interest does indicate '490 had special value and was of great importance in hinging heavy doors on "tumble-in" bodies.

POINT X, ARGUMENT

A. Pages 1, last line, and 16, next to last par., state this Court is requested to make

an evidentiary review of the record. Page 12 of this Reply has indicated already that F.R.C.P. 52(a) has no finality where the evidence in the record does not support the legal conclusion of obviousness. A legal conclusion drawn from facts interpreted wrongly or overlooked must be, itself, wrong. Much of the preceding Reply applies to this argument, and will not be repeated at great length.

B. The confusion in this case is due, first, to the defendant's contention that the Howe invention is overclaimed to cover any hinge, and hence the '490 claims read on the pre-De Soto butt hinges, and even on those to the gates in Heaven. In its Motion for More Definite Statement (P.A. 33(2)) GM inquired if it is charged with infringement of the use of the hinge per se. The Response was (P.A. 43(2)) that infringement is charged by the "use of such structures in automotive vehicles manufactured, used, or sold by defendant." Defendant

persisted, nevertheless, in the defense which Judge Robson and the reviewing court sustained, that the claims were for a hinge per se. Judge Picard's opinion and Judge La Buy's finding No. 18 (Pet. Bk. 16) construed the claims, in the light of the description and drawings, to call for a concealed hinge "for supporting" or "adapted to support" a door.

The second cause of the confusion is due to the contention that '490 claimed a solution of hinging so that the door would move parallel to the ground to cause proper alignment of the door in the opening provided in the body. Since such alignment was disclosed, this result was obvious. As Judge Picard concluded (p.14,15,supra) this was but half the broad problem or another problem. It was not solved wholly in the post-De Soto tumble-in cars, since pinch bars had to be used, and more remained to be done to get satisfactory alignment (Pet. Bk. 5, col. 2,

next to last par.). While Smith pioneered with the inclined axis hinge, Howe eliminated the need for persuasion by a type of hinge which modified the pillar. But part of the broad problem, or another related problem, was to so align that no part of a pintle-type hinge (butt or gooseneck) would protrude beyond the body wall or be visible from either outside or inside the car. Carr's was exposed over the back seat, as well as at the fender which covered it. No combination prior art reference anticipated '490. Absent such a "knockout" reference, shot gun references were resorted to, to show what Howe did was obvious from disclosures in pre-De Soto and post-De Soto art. Of the latter, the closest was Smith and he admitted what Howe did could not be done with pintle hinges, except to add an exposed butt hinge to a concealed gooseneck hinge. To establish its mosaic, the lower courts did not cite which patent was primary and which supported it.

It is established patent law that one reference only can anticipate, but two such references are required to show such disclosures made the claimed invention obvious. (Appendix C will show that the Seventh Circuit holds erroneously that one patent only will thus suffice.) Even so, it is also established law that no prior patent or publication is a valid reference unless it has disclosed the broad problem or the other problem, as involved in the case at bar. Pet. Appendix A shows Smith only was aware of the problem.

C. Brief, page 10-11, quotes Howe's testimony in the trial before Judge Perry as admitting the alignment problem to be the same in the tumble-out art from which the solution was obvious. Slyly, it notes at page 11, after quotes, this impeaching testimony was read to him upon cross in the trial before Judge Robson (P.A. 358). It failed to quote the record accurately and fully, because the cross continued: "Now, are you

changing your testimony now, Mr. Howe?"
A. "Well, I was wrong in that statement, in that I didn't consider the other problems that were attendant with the tumble-in bodies."
Q. "So you are changing your testimony now?"
A. "In that respect, yes."

D. Contrast this with the critical admission against interest by Lutz, its $50 per hour expert, which goes to the heart of the case at bar (DA II, 1599-1600):
Q. "You say that there was nothing <u>new</u> or <u>unexpected</u> in the Howe patent?" A. "That's right."
Q. "Yet, there is not anything in the prior art which shows a pintle-hinge supporting a door in an automobile inclined inwardly in a converging top automobile with a hinge entirely concealed and the inclination on that axis compensated for by the hinge, isn't that true?" * * * A. "Correct, and all of those phrases (a concealed hinge for supporting the door) read on the top hinge of the B.O.P."
Q. "Yet the fact is that in a B.O.P. you have

had to have two hinge means, did you not?" A. "Two hinges, correct." Q. "No car was ever made or ever sold of that variety which had only one top hinge to support the door?" A. "That is correct." Q. "And the top hinge alone can't support the door?" A. "That is correct."

E. In the above respect, the case at bar shows the new and unexpected result which should have been considered as it was in Adams. Other similarities with U.S. v. Adams are the following:

a. Adams was told his invention was fantastic. Smith told the industry that there could be no alignment by pintle hinges alone, that even if one were concealed another had to be exposed for additional support.

b. The U.S. later got a patent as did GM on its assist and adopted Howe. (GM use of Howe hinge. Figures for 1939 - 1955 at DA III 2117-2121, summarized on 2121).

c. The chemical compositions were equivalent in the prior art, but Adams added that little something as did Howe, Judge Picard having pointed out the structural differences.

d. In both the test was applied whether the difference between the claimed inventions and the prior art had an identity of operation and result. They had not, nor was the pre-De Soto prior art purposes the same as Howe's.

e. The lower court did not go seriously into the claim of confidential disclosure because it held Adams could not recover twice.

F. The dissimilarities between '490 and Graham are that the latter did not even describe the flex to support a claim therefor; Graham's own expert testified it was minimal; there was no confidential disclosure and the same substantial degree of secondary considerations, if any, were missing in Graham; there was no such record of experimental history as there was in '490 (DA III 1929; 1854-55; 1785; 1796-97; 1806; 1812-13; 1818-19; 1832-33) which Brief 16 asserts was "pure fantasy".

CONCLUSION

Respondent's Brief states no valid objections to the grant of the writ. The Petition and this Reply show that great departures have taken place in the lower courts from the guidelines laid down by this Court in both Graham and U.S. v. Adams. Appendix C shows the many twilight areas in patent law areas which relate to the issues in the case at bar, and amplifies some in the Seventh Circuit that require resolution. The issuance of the writ is prayerfully prayed.

Respectfully submitted,

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APPENDIX C

The 10 twilight areas in patent infringement litigation needing resolution by this Court are listed in a sequence following more nearly the progress of the cause. The figure within parenthesis indicates the order of its appearance on Pet. 11-12.

AREA

1 (3) Confusion Between Court and Jury Functions.

See Pet. 14-15; Point III, Subject Index. GM's attempt to defeat Howe's right to a jury trial under the 7th Amendment raises the question as to the limitations this Court should place on the determination of the laches or other equitable issues first which, if successful, will defeat that constitutional guarantee. Earle v. Sawyer, 8 Fed. Case No.4247 (Mass.1825); Hotchkiss v. Greenwood, 12 Fed.Case No.6718(Oh.,1848), and Many v. Sizer, 15 Fed.Case No.9056(Mass.1849); were all jury cases involving relative functions in deciding questions of law and of facts. In more recent times, the 5th Cir. cases of Thermo v. Chem.,294 F.2d 486(1961) (an excellent history), and Swofford (1968)(Pet.15); the 9th Cir.cases of Beatty v. Upright, 306 F.2d 626(1962), and Shubin v. U.S. Oil, 313 F.2d 250(1963); and the 10th Cir. case of Admiral v. Zenith, 296 F.2d 708(1961) bear on this question in relation to FRCP 38(a) and 42(b).

One commentator, in 49 J.P.O.S. 130-31,raises the question whether Graham has not eliminated the need for a jury.

2 (7) Divergencies in Various Courts' Interpretations of the Presumption of Validity Under Sec. 282.

See Pet. 30-32; Reply 8. The cases show considerable confusion, even among different panels in the same Cir. as is true in the 7th,as to the

effect of omission of a non-file wrapper reference. Some ignore the omission entirely. Others hold no resumption or inference arises, as it is just as reasonable to suppose it was considered and rejected tho not mentioned. Others say omission weakens, or does not aid the plaintiff, or that it destroys completely the presumption. Others hold one such omission is enough. Others make inquiry whether the omitted reference is the most pertinent, or whether the file wrapper references are of equal or better pertinence.

2d Cir.	David v. Meyerson, 388 F.2d 292 (1968)
3d "	Sperti v. Coca Cola, 399 F.2d (1967)
4th "	Power Curbers v. Etnyre, 298 F.2d 484 (1962)
	Universal v. Kay, 301 F.2d 140 (1962)
	Berry Bros. v. Signon, 317 F.2d 700 (1963)
5th "	Siskow v. Southern, 373 F.2d 866 (1967)
	Metal Arts v. Fuller, 389 F.2d 319 (1967)
	Smith v. Hughes, 396 F.2d 735 (1968)
6th "	Preformed v. Fanner, 328 F.2d 265 (1964)
	F.M.C. v. Myers, 384 F.2d 4 (1967)
	Goodrich v. Rubber Latex, 400 F.2d 401 (1968)
7th "	Crane v. Spitfire, 276 F.2d 271 (1960)
	Ekstrom v. Onsrud, 298 F.2d 765 (1962)
	MMM v. Technical, 309 F.2d 55 (1962)
	Shumaker v. Gem, 311 F.2d 273 (1962)
	Devex v. GM, 321 F.2d 234 (1963)
	Milton v. Potter, 327 F.2d 437 (1964)
	Schnell v. Allbaugh, 348 F.2d 444 (1965)
	Zegers v. Zegers, 365 F.2d 156 (1966)
	Great Lakes v. Reese, 402 F.2d 346 (1968)
9th "	Neff v. Cohu, 298 F.2d 82 (1961)
	Beatty v. Upright, 306 F.2d 626 (1962)
10th "	Admiral v. Zenith, 296 F.2d 708 (1961)

3 (5) What is Meant by Prior "Pertinent" Art?

See Pet. 24; Reply 13-15. Inquiry has ranged far afield at times, depending on construction of claims (Pet.16-17; Reply 12,13-15), into lost art, "accessory" art,etc. The test has been generally if the references show an identity of operation, similarity of results, or similar structural characteristics:

D.C. Cir.	Comm'r v. Deutsche, 397 F.2d 658 (1968)
3d "	Egan v. Modern, 387 F.2d 319 (1967)
6th "	Kaiser v. McLouth, 400 F.2d 36 (1968)

7th Cir. MMM v. Technical, 309 F.2d 55 (1962)
Deyex v. GM, 321 F.2d 234 (1963)
Nordberg v. Jackson, 393 F.2d 192 (1968)
See also 32 Geo.Wash. L.R.656 (1964);
Amer U.L.R. 211 (1964); 35 Geo.Wash.
L.R. 818(1967); 50 J.P.O.S. 214(1968).

9th " Pursche v. Atlas, 300 F.2d 467 (1961)
Beatty v. Upright, 306 F.2d 626 (1962)
Yavitch v. Seewick, 323 F.2d 560 (1963)

4 (1) The Confusion Due to Citing Sec.102 References as Anticipatory Under Sec.103.

1st Cir. Colour Pictures v. Mike,394 F.2d 431(1968)

2d " Continental Can v. Old Domin.,393 F2d 321 (1968)

3d " Rains v. Cascade, 402 F.2d 241 (1968)

4th " Berry Bros.v.Signon,317 F.2d 700 (1963)

6th " Allied Wheel v. Rude,206 F.2d 752 (1953)
Kaiser v. McLouth, 400 F.2d 36 (1968)

7th " Minn.Honey v.Midwest,298 F.2d 36 (1961)
Copease v. Amer.,298 F.2d 772 (1961)
Ekstrom v. Onsrud, 298 F.2d 765 (1962)
Johnson v. Kendall, 327 F.2d 391 (1964)
Milton v. Potter, 327 F.2d 437 (1964)
Briggs v. Diesel, 342 F.2d 573 (1965)
Toro v. Jacobsen, 357 F.2d 901 (1966)
Nat'l Dairy v. Borden,394 F.2d 887 (1968)
Amphenol v. General, 397 F.2d 431 (1968)
Ill.Tool v. Continental,397 F.2d 517 (1968)
Great Lakes v. Reese,402 F.2d 346 (1968)

9th " Ceramic v. Tile, 378 F.2d 283 (1967)
Jeddeloh v. Coe, 375 F.2d 85 (1967)

5 (2) Must Inquiry Be Made Under Sec.103 Into Prior Art Purposes and Results,as Well as Structural Differences?

D.C.Cir. Comm'r v. Deutsche,397 F.2d 658 (1968)

3d " Egan v. Modern, 387 F.2d 138 (1967)

5th " Metal v. Fuller, 389 F.2d 319 (1968)

7th " Crane v. Spitfire,276 F.2d 271 (1960)
Ekstrom v. Onsrud, 298 F.2d 48 (1962)
Devex v. GM, 321 F.2d 234 (1963)
Johnson v. Kendall,327 F.2d 391 (1964)
Welsh v. Chernivski, 342 F.2d 586 (1965)

10th " Admiral v. Zenith, 296 F.2d 708 (1961)

7 (9) How Certain,Clear and Operable Must Foreign Patent or Publications Be?

2d Cir. Rich v. Mitchell,357 F.2d 176 (1966)
Preususs v. GE, 392 F.2d 29 (1968)
6th " Allied Wheel v. Rude, 206 F.2d 752 (1953)

8 (6) How Far Are Disclosures in Non-Anticipatory Art Pertinent to Sec. 103 Obviousness?

2d Cir. Ling Temco v. Kollsman,372 F.2d 263 (1967)
3d " Corning Glass v. Anchor, 374 F.2d 473(1967)
4th " Grinnell v. Va., 401 F.2d 451 (1968)
5th " Nat'l Filters v.Research,383 F.2d 516(1967)
6th " Allied Wheel v. Rude, 206 F.2d 752 (1953)
Preformed v. Fanner, 328 F.2d 265 (1964)
7th " Crane v. Spitfire, 276 F.2d 271 (1960)
Toro v. Jaconsen, 357 F.2d 901 (1966)

9 (8) Erroneous Conclu ions of Law Confused With Erroneous Conclusions as to Facts.

D.C.Cir.Comm'r v. Deutsche, 397 F.2d 656 (1968)
1st " United Shoe v.Industrial,335 F.2d 577(1964)
2d " Royal v. Smith, 295 F.2d 1 (1961)
5th " Swofford v. B&W, 395 F.2d 362 (1968)
6th " Goodrich v. Rubber, 400 F.2d 401 (1968)
7th " Copease v. Amer., 298 F.2d 772 (1961)
P&D v. Winter, 334 F.2d 830 (1964)
9th " Ceramic v. Tile, 378 F.2d 283 (1967)
10th " Admiral v. Zenith, 296 F.2d 708 (1968)

10 (10) No Uniformity Exists Re Consideration of Secondary Indicia of Non-Obviousness,Much Being Left to Trial Judge's "Intuitive Leap."
5th Cir.Smith v. Hughes, 396 F.2d 735 (1968)
6th " G.E. v. Sciaky, 304 F.2d 724 (1962)
7th " Shumaker v. Gem, 311 F.2d 273 (1962)
Great Lakes v. Reese, 402 F.2d 346 (1968

6 (4) What is Meant by "As a Whole" in S.103?

4th Cir. Power Curbers v. Etnyre, 298 F.2d 484 (1962)